

REMARKS

Claims 1-6, 11-89 are pending in the patent application. Claims 7, 13, 14, 16, 21, 30-32, 34, 37, 41-48, 57, 58, 60-64, 66, 67, 71-78, 81-86, and 88 are withdrawn. Claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89 were rejected in the office action mailed on September 18, 2006.

35 U.S.C. § 103 Rejection

Claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89 were rejected based on 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent Publication No. 61-14557 (“Hatanaka”), in view of United Kingdom Patent Application No. GB 2088832A (“Fujii”), and further in view of U.S. Patent No. 5,394,992 (“Winkler”), and U.S. Patent No. 5,761,089 (“McInerny”). One basic requirement for a *prima facie* case of obviousness is that the prior art references must teach or suggest all of the claim limitations. M.P.E.P. § 2143. Hatanaka in view of Fujii and further in view of Winkler and McInerny does not satisfy this test.

Claim 1 of the present application recite several limitations, among them “a processing module coupled to the input receptacle and adapted to process the currency bills and substitute funds.”

Claim 11 recites “an evaluation unit comprising at least one currency detector disposed along the transport path between the input receptacle and the output receptacle, the at least one currency detector being capable of evaluating currency bills, and a first media detector disposed along the transport path between the input receptacle and the output receptacle, the first media detector being capable of evaluating substitute currency media.”

Claim 56 recites “an evaluation unit including a first sensor disposed along the transport path between the input receptacle and the output receptacle, the first sensor being adapted to detect at least one characteristic of a currency bill, and a first barcode reader disposed along the transport path between the input receptacle and the output receptacle, the barcode reader being adapted to scan a barcode.”

Claim 79 recites “an evaluation unit disposed along the transport path between the input receptacle and the plurality of output receptacles, the evaluation unit comprising at least one currency sensor and a barcode reader positioned adjacent the transport path, the at least one

currency sensor being adapted to obtain denomination characteristic information of a first currency bill, the barcode reader being adapted to scan for a barcode on a document from the stack of documents passing along the transport path, a document on which the barcode reader detects a barcode being termed a valid barcoded medium, a document on which the barcode reader does not detect a barcode being termed an invalid barcoded medium.”

Claim 87 recites “an evaluation unit comprising at least one scanner disposed along the transport path between the input receptacle and the output receptacle, the at least a first scanner being capable of scanning for at least one characteristic associated with a currency bill, the evaluation unit further comprising a second scanner capable of scanning for at least one characteristic associated with a substitute currency medium.”

Claim 89 recites “an evaluation unit comprising a detector disposed along the transport path between the input receptacle and the output receptacle, the detector being adapted to detect characteristic information associated with a currency bill and characteristic information associated with a redeemable document.”

There is no teaching or suggestion within Hatanaka of any documents other than currency notes being evaluated. Rather, Hatanaka discloses a device that may identify and count “notes of paper currency.” p. 3, ll. 1-4. In fact, the entire disclosure of Hatanaka is directed to currency notes, and no reference is ever made to any other type of media that may be processed by Hatanaka.

Fujii also only discloses a device that is only adapted to evaluate currency notes. Fujii teaches that a reason for rejecting a note may be stored in a memory, however, Fujii in no way teaches or suggests the ability to process substitute funds, substitute currency, or barcoded media.

Similarly, both McInerny and Winkler are directed to processing currency bills, and do not disclose or suggest the ability to process documents that may be substituted for currency.

Therefore, there is no teaching or suggestion within the cited references of the capability of processing both genuine currency bills, and other documents that are used to represent monetary values.

In fact, the Examiner has admitted that the cited references fail to disclose “substitute funds,” “casino script,” paper tokens,” “gift certificates,” “retailer coupons,” and “bar coded tickets.” The Examiner has simply stated that these type of documents are the “functional equivalent” of currency bills. However, the Examiner has failed to cite a single reference

disclosing the recitations of the pending claims regarding substitute currency, or bar coded documents. Therefore, the Examiner has failed to show that the prior art references cited teach or suggest all of the recited limitations, and thus, a *prima facie* case of obviousness has not been shown.

In addition to the previous reasons the cited references fail to make *prima facie* case of obviousness, with regards to independent claims 11, 56, 79, 87, the Examiner has failed to cite a teaching within the references cited that disclose a "media detector," a "barcode reader," or a "second scanner capable of scanning for at least one characteristic associated with a substitute currency medium" in addition to a separate detector, sensor, or scanner used to process currency as recited in these claims.

Claims 2-6 depend either directly or indirectly from claim 1. As not all of the limitations of claim 1 are taught or suggested by Hatanaka in view of Fujii and further in view of Winkler and McInerny, not all of the limitations of claims 2-6 are taught or suggested by Hatanaka in view of Fujii and further in view of Winkler and McInerny.

Claims 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, and 49-55 depend either directly or indirectly from claim 11. As not all of the limitations of claim 11 are taught or suggested by Hatanaka in view of Fujii and further in view of Winkler and McInerny, not all of the limitations of claims 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, and 49-55 are taught or suggested by Hatanaka in view of Fujii and further in view of Winkler and McInerny.

Claims 59, 65, and 68-70 depend either directly or indirectly from claim 56. As not all of the limitations of claim 56 are taught or suggested by Hatanaka in view of Fujii and further in view of Winkler and McInerny, not all of the limitations of claims 59, 65, and 68-70 are taught or suggested by Hatanaka in view of Fujii and further in view of Winkler and McInerny.

Claim 80 depends directly from claim 79. As not all of the limitations of claim 79 are taught or suggested by Hatanaka in view of Fujii and further in view of Winkler and McInerny, not all of the limitations of claim 80 are taught or suggested by Hatanaka in view of Fujii and further in view of Winkler and McInerny.

Double Patenting Rejections

Claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-73 of U.S. Patent No. 6,880,692, claims 1-78 of U.S. Patent No. 6,913,130, claims 1-91 of U.S. Patent No. 6,959,800, claims 1-31 of U.S. Patent No. 6,955,253, or claims 1-26 of U.S. Patent No. 6,868,954.

Claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7-29, 78-89, and 146-149 of copending Application No. 10/713,328.

To overcome these rejections, Terminal Disclaimers are submitted herewith.

Conclusion

The Applicants submit that the claims are in a condition for allowance and action toward that end is earnestly solicited. A check in the amount of \$130.00 is included to cover the fee of the Terminal Disclaimer submitted herewith, and no additional fees are believed due with this paper. Should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkens & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47171-00305USP1.

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Respectfully submitted,

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